

REMARKS

The Office Action dated May 22, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 2, 4, 5, 7, 13-17, 21, 22, 25-27, 30, and 31 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter is believed to have been added. Claims 1-31 are currently pending and are respectfully submitted for consideration

Reconsideration and withdrawal of the objections and rejections is respectfully requested in light of the following remarks.

Applicants respectfully submit that because all of the claimed elements have not been explicitly considered on the record, the Office Action is incomplete, for at least the following reasons. MPEP § 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)” (emphasis added). “‘The identical invention must be shown in **as complete detail** as is contained in the ... claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)” (emphasis added). Moreover, “[e]very element of the claimed invention must be literally present, **arranged as in the claim.**” *Id.* (emphasis added). In the present case, the Office Action has not established that each element of the claims is disclosed in

Agrawal. In fact, certain features recited in the claims, as amended in the previous Response filed on March 12, 2008, were not addressed at all in the Office Action mailed on May 22, 2008. Because all of the claimed features have not been explicitly considered in the record, the Office Action is not complete as to all matters, as required by 37 C.F.R. § 1.104(b). Since the disposition of these features is unclear, Applicants note that consideration of these features will be presented in the next Office Action for the first time on the record. As such, a next Office Action in this case **cannot** be made final.

However, as discussed below, the Applicants have respectfully traversed the objections and rejections set forth by the Office Action.

Claim 1 was objected to because of informalities. Applicants have amended claim 1 as suggested by the Examiner. Accordingly, withdrawal of the objection is respectfully requested.

Claims 1-17 and 21-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Agrawal (U.S. Patent Publication No. 2002/0083127). The Office Action asserted that Agrawal discloses all of the elements recited in claims 1-17 and 21-30. However, this assertion by the Office Action is respectfully traversed as follows.

Claim 1, upon which claims 2-6, 8-12, 18-20, 23, 24, 26 are dependent, recites a communication system. The communication system includes a presence information unit configured to provide presence information associated with a plurality of users the presence information comprising a plurality of elements associated with each user. The communication system includes a storing unit configured to store information defining at

least one group, the group containing a plurality of users. The communication system also includes an information providing unit configured to provide information defining for each user of the group which elements of the presence information are to be provided to at least one user, wherein for at least one user of the group, the provided information defines a subset of the elements of the presence information.

Claim 27, upon which claims 28 and 29 are dependent, recites a communication method. The communication method includes defining at least one group, the group containing a plurality of users with which presence information is associated, the presence information comprising a plurality of elements associated with each user. The method also includes defining for each user of the group which elements of the presence information are to be provided, wherein for at least one user of the group, the provided information defines a subset of the elements of the presence information.

Claim 30, upon which claims 7, 13-17, 21, 22, and 25 are dependent, recites a communications entity. The communications entity includes a storing unit configured to store. The communications entity includes a first information defining at least one group, wherein the group comprises a plurality of users with which presence information is associated, and wherein the presence information comprises a plurality of elements associated with each user. The communications entity includes a second information defining for each user of the group which elements of the presence information are to be provided, wherein for at least one user of the group, the provided information defines a subset of the elements of the presence information.

Claim 31 recites a communication system. The communication system includes a presence information providing means for providing presence information associated with a plurality of users, the presence information comprising a plurality of elements associated with each user. The communication systems includes a storing means for storing information defining at least one group, the group containing a plurality of users. The communication systems includes an information providing means for providing information defining for the each user of the group which elements of the presence information are to be provided, wherein for at least one user of the group, the provided information defines a subset of the elements of the presence information.

As will be discussed below, Applicants respectfully submit that Agrawal fails to disclose, either expressly or inherently, all of the elements of the claims, and therefore fails to provide the advantages and features as discussed above.

Agrawal generally discusses a method and system for providing application level presence information in a wireless network (see Agrawal, Abstract). More particularly, Figure 1 of Agrawal illustrates a wireless communication network 100 [that] includes mobile clients 102, 104 that use mobile communication devices such as ... cell phones or personal digital assistants (see Agrawal, Paragraph [0024]). The mobile clients 102, 104 are in communication with an application server 106 that is configured to provide ... instant messaging or other application services. A presence server 108 is in communication with the application server 106 and is configured to provide user presence data to the application server 106.

However, Applicants respectfully submit that Agrawal fails to disclose, either expressly or inherently, all of the limitations recited in claim 1. For example, Agrawal fails to disclose, either expressly or inherently, in part, “an information providing unit configured to provide information defining for each user of said group which elements of said presence information are to be provided to at least one user, wherein for at least one user of said group, said provided information defines a subset of said elements of said presence information”, as recited in claim 1, and as similarly recited in claims 27, 30 and 31.

The Office Action asserted that Paragraph [0041] of Agrawal discloses configuring presence information and only providing that information which is requested (see Office Action, Page 3, Lines 7-8). However, Paragraph [0041] of Agrawal states:

[u]ser presence data can be used in various applications. For example, a buddy list can be presented to an instant messaging user to identify members of the buddy list that are currently available. Alternatively, user presence data can be configured to indicate when a user will become available, or if a user is reachable, but not currently available. User presence data can be configured to provide alerts as users log on or off an application such as an instant messaging application, or designate an address for message delivery. For example, user presence could indicated that a user is available by cell phone and currently unavailable by desktop. In addition, user presence data can include cell phone status such as data or voice mode indications and applications configured to transmit messages appropriately.

Stated another way, Paragraph [0041] of Agrawal is merely concerned with the use of presence data by applications and describes a number of possible user states that may be indicated by the user presence data.

However, there is no teaching or suggestion by Agrawal that only certain elements of the presence information should be provided. For example, there is no teach or suggestion by Agrawal that information is provided that “defin[es] for each user of said group which elements of said presence information are to be provided to at least one user, wherein for at least one user of said group, said provided information defines a subset of said elements of said presence information”, as recited in claim 1, and as similarly recited in claims 27, 30, and 31.

Furthermore, configuration of the user presence information to include certain desired fields, does not imply that a subset of required elements of presence information should be defined, which appears to be the assertion by the Office Action. As such, there is no suggestion in Agrawal that a subset of the available elements of presence information should be defined at all. Applicants respectfully submit that the Office Action has applied impermissible hindsight to make the leap from the disclosures of Agrawal, of configuring presence information to indicate certain states, to the limitation “an information providing unit configured to provide information defining for each user of said group which elements of said presence information are to be provided to at least one user, wherein for at least one user of said group, said provided information defines a subset of said elements of said presence information”, as recited in claim 1, and as similarly recited in claims 27, 30 and 31.

Therefore, Applicants respectfully submit that Agrawal fails to disclose, either expressly or inherently, all of the limitations recited in independent claims 1, 27, 30, and

31. Claims 2-6, 8-12, 18-20, 23, 24, and 26 are dependent upon independent claim 1, claims 7, 13-17, 21, 22, and 25 are dependent upon independent claim 30, and claims 28 and 29 are dependent upon independent claim 27. Therefore, Applicants respectfully submit that dependent claims 2-17 and 21-26, 28, and 29 should be allowable for at least the same reasons as their respective base claims, and for the specific limitations recited therein.

Claims 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Agrawal in view of Requena (U.S. Patent Publication No. 2007/0124471). Particularly, the Office Action asserted that the combination of Agrawal and Requena disclosed all of the elements of claims 18-20. However, this assertion by the Office Action is respectfully traversed as followed.

Applicants respectfully submit that Requena is a patent application that was filed (e.g. January 17, 2007) and published (e.g. May 31, 2007) later than the filing date (e.g. June 23, 2005) of the present application, and, therefore, fails to qualify as prior art under 35 U.S.C. §§ 102 and 103. Furthermore, nothing was cited or found in Requena, which generally discusses instant messaging, that cures the above-mentioned deficiencies of Agrawal as discussed above with respect to independent claims 1, 27, 30, and 31. As such, Applicants respectfully submit that dependent claims 18-20 inherit the patentable features of their respective base claims by virtue of their dependency.

Therefore, Applicants respectfully submit that the subject matter disclosed in claims 18-20 should be allowed for at least the reasons stated above. Accordingly, withdrawal of the rejection is respectfully requested.

For at least the reasons discussed above, Applicants respectfully submit that none of the cited references, whether considered alone or in combination, disclose, either expressly, implicitly or inherently, all of the elements of the claimed invention. These distinctions are more than sufficient to render the claimed invention unanticipated and unobvious. It is therefore respectfully requested that all of claims 1-31 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Petition for Extension of Time
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